



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/763,848

01/23/2004

Hisanori Nonaka

83394.0021

8221

26021 7590 03/10/2009

HOGAN & HARTSON L.L.P.  
1999 AVENUE OF THE STARS  
SUITE 1400  
LOS ANGELES, CA 90067

EXAMINER

CHONG CRUZ, NADJA N

ART UNIT

PAPER NUMBER

3623

MAIL DATE

DELIVERY MODE

03/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## **DETAILED ACTION**

### **Status of Claims**

1. This is a Final office action in reply to the response filed on 9 December 2008.
2. Claims 1-3, 8 and 10 have been amended.
3. Claims 1-10 are currently pending and have been examined
4. The rejections of claims 1-10 have been updated to reflect the amendments

### **Response to Amendment**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.
6. The objections of the Drawings in the previous office action are withdrawn, in response to Applicant's amendments. The examiner thanks the applicant for correcting this minor flaw.
7. The objection of the Abstract of the disclosure in the previous office action is withdrawn, in response to Applicant's amendments. The examiner thanks the applicant for correcting this minor flaw.
8. The objection of claim 8 in the previous office action is withdrawn, in response to Applicant's amendments.

### **Specification**

9. The disclosure is objected to because of the following informalities:
10. The amendment filed 13 November 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: at the beginning of the paragraph at page 17, line 8, "similar to Program Change Notice 1201" in Figure 12 is not supported by the original disclosure because Figure 12 does not show reference character "1201". Therefore, it was not presented at the time the application was filed. Applicant is required to cancel the new matter in the reply to this Office Action.

**Claim Rejections - 35 USC § 112**

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per claim 1, recites *direct arbitral object* and *indirect stake holders*. These limitations are not supported by the original disclosure.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 1-3 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
15. As per claim 1 recites *a direct arbitral object*. A direct arbitral object is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because how an object is direct and arbitral at the same time?
16. As per claim 1 recites *indirect objects* and *said direct objects*. Examiner is not clear how direct and indirect objects are classified? What is a direct and indirect object? What is the difference between a direct and indirect object? Is there a difference?
17. As per claim 1, recites *said direct object*. There is insufficient antecedent basis for this limitation in the claim.
18. As per claims 1-3, recites *a computer readable medium encoded with a project program change management system* is indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention because the claimed invention is directed to neither a "system" nor a "machine".

19. As per claim 10, recites *a computer readable medium encoded with a project program change management method* is indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the claimed invention is directed to neither a "process" nor a "machine".

**Claim Rejections - 35 USC § 101**

20. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

21. Claims 1 – 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As recited, claims 1 – 10 are directed toward a computer program, software per se. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 1 – 10, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claims 1 – 10 are not eligible for patent protection.
22. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to neither a "system" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), at 1551. See also MPEP 2173.05(p)(11).
23. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of

invention in the alternative only. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), at 1551. See also MPEP 2173.05(p)(11).

24. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent and recent Federal Circuit decisions, 88 USPQ2d 1385 *In re Bilski* U.S. Court of Appeals Federal Circuit. A method claim must meet a specialized, limited meaning to qualify as a patent-eligible process claim. As clarified in *Bilski*, The test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing. This is called the "machine or-transformation test" (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).
25. There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such a data gathering or outputting, is not sufficient to pass the test.
26. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Art Unit: 3623

27. Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

#### **Response to Arguments**

28. Applicant's arguments received on 9 December 2008 have been fully considered but are not persuasive.
29. In particular Applicant argues that the prior art of record, specifically that the (1) *applied references fails to disclose or suggest the features of the claims of the present invention: a computer readable medium ... indirect people who have a stake in indirect task cannot see the changes made to a main task modified by the direct person responsible for that task* (page 13, second paragraph) and (2) *the applied references fails to disclose or suggest "the indirect stakeholders of said indirect objects are notified of changes of said direct objects* (page 13, last paragraph).
30. With regards to argument (1). Examiner respectfully disagrees. Miller teaches a task management system for managing a plurality of tasks to be carried out by a plurality of personnel (Miller, Abstract). Further, please see the updated rejection below as necessitated by amendments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *indirect people who have a stake in indirect task cannot see the changes made to a main task modified by the direct person responsible for that task*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
31. With regards to argument (2). Examiner respectfully disagrees. Please see the updated rejection below as necessitated by the amendments.

**Claim Rejections - 35 USC § 102**

32. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

33. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 6,101,481).

**Claim 1:**

Miller as shown discloses a system and program for task management, the system and program comprising:

- *an input means to input a project program change regarding a direct arbitral object that compose works of a project* (Column 8, lines 63-64: which teaches that “[f]illing in the boxes in the template develops a useful plan and establishes input data simply and speedily” and Figures 3 and 3A which they illustrate the input of data to modify task details of a project);
- *a project change influence inference means that infers and specifies indirect objects different from said direct object that compose works of a project and which are indirectly influenced by said project program change of said direct object in response thereto* (Figure 10 illustrates a change to actual end date of a task (e.g., a direct object) where by modifying the actual end date of a task influence indirectly the child task (e.g., indirect object) of a parent task as illustrated in Figure 16.)
- *a stake holder inference means that infers and specifies indirect stake holders who are relevant to said indirect objects inferred and specified in said project change influence inference means* (Figure 3, which it illustrates the determination of who is directly and indirectly involved in the task (e.g., indirect stake holders who are



relevant to said indirect objects) and Figure 12 which it illustrates that after a modification notifies "the person responsible" (e.g., indirect stake holders) "that an adjustment" (e.g., project change) "has been proposed";

- *and an information notice means that notifies information regarding influence of contents of program change to the indirect stake holders of said indirect objects who are inferred and specified by said stake holder inference means* (Figure 12, which it illustrates that after a program change "[n]otify the person responsible" (e.g., indirect stake holders) "that an adjustment has been proposed");
- *wherein the indirect stakeholders of said indirect objects are notified of changes of said direct objects* (Figure 12, which it illustrates that after a modification notifies "the person responsible" (e.g., indirect stake holders) "that an adjustment" (e.g., direct object) "has been proposed");

**Claim 9:**

Miller as shown discloses the following limitations:

- *a process to infer and specify not only direct but also indirect influences by said project program change is included* (Figure 3, which it illustrates that "[f]or each task determine who is directly and indirectly involved in the task" where Miller teaches that the process determines direct and indirect influences (e.g., people involved));

**Claim Rejections - 35 USC § 103**

- 34.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35. Claims 2-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,101,481) in view of Barnard et al (US 2002/0103731 A1) hereinafter "Barnard".

**Claim 2:**

Miller as shown discloses a system and program for task management, the system and program comprising:

- *an input (step) means to input a project program change regarding arbitral objects that are works comprising construction, development and manufacturing of a project* (Column 8, lines 63-64: which teaches that "[f]illing in the boxes in the template develops a useful plan and establishes input data simply and speedily" and Figures 3 and 3A which they illustrate the input of data to modify task details of a project, Figure 1 illustrates projects and task, column 2 lines 62-63: which teaches "coordinating a plurality of tasks" (e.g., construction, development and manufacturing of a project) "to be carried out by a plurality of task personnel" and column 7, lines 36-37 which teaches "display of relevant tasks is constructed using direct involvement");
- *a stake holder inference (step) means that infers and specifies stake holders who are relevant to said objects inferred and specified in said project change influence inference means* (Figure 3, which it illustrates the determination of who is directly and indirectly involved in the task (e.g., stake holders) and Figure 12 which it illustrates that after a modification notifies "the person responsible" (e.g., stake holders) "that an adjustment" (e.g., project change) "has been proposed");
- *and an information notice (step) means that notifies information regarding influence of contents of program change to those stake holders who are inferred and specified by said stake holder inference means* (Figure 12, which it illustrates that after a program change "[n]otify the person responsible" (e.g., stake holders) "that an adjustment has been proposed");

- *wherein said project change influence inference means infers and specifies objects that are to be influenced by said project program change by using information, being stored in a data storage means therein, of the restrictive condition regarding said project* (Figure 19 which it illustrates a data storage means, Figure 3 which it illustrates an input template including start and complete dates (e.g., restrictive conditions) and Figures 15 and 15A, column 10, lines 23-26 where Miller discloses a change involving task dates and how those areas that are affected are informed of the change, the restrictive condition is the parent task dates and the change is the time blowout);

Miller does not disclose the following limitation, however Barnard in an analogous art of task management for the purpose of project development (page 2, ¶ 0020) as shown, does:

- *a project change influence inference (step) means that infers and specifies objects which are influenced by said project program change in response thereto* (page 5, ¶ 0053, page 7 and 9, Table 4, which teaches that “[a] user with appropriate authority may then view, correct, update, approve or otherwise modify the displayed task” where in Table 4 illustrates that when Task ID P83 is modified, the system “[a]ssess customer impact” (e.g., influence) “on internal Enterprise workload” (e.g., object). Barnard teaches that the invention as disclosed infers and specifies objects/task in response to a modification in Task ID P83. In addition, Task ID PD42, the system “[a]ssess supplier impacts related to transition management” (e.g., changes/modifications in transition management) and Task ID PD43, the system then “[a]ssess Enterprise support impacts related to transition management”);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine what objects (e.g., tasks, activities, deliverables) are influenced by a change as taught by Barnard, to improve Miller task management, thereby giving the predictable

result of “tracking team activities” (Barnard, page 2, ¶ 0022) and to control and monitor “a project by storing and maintaining the result of the project activities” in order “to ensure consistency and data accuracy” (Barnard, page 14, Table 9, Description).

**Claim 3:**

The limitations of claim 3 encompass substantially the same scope as claim 2. Accordingly, those similar limitations are rejected in substantially the same manner as claim 2, as described above.

The following are the limitations of claim 3 that differ from claim 2.

Miller as shown discloses a system for task management, the system comprising:

- *said stake holder inference means that infers and specifies stake holders who are relevant to said objects which are to be influenced by said project program change by using information, being stored in a data storage means therein, of peoples and organization regarding said project (Figure 19 which it illustrates a data storage means and Figure 2 which it illustrates an input of who are responsible and involved in a task);*

**Claim 4:**

Miller as shown discloses the following limitation:

- *a process that manages information regarding approvals given by said stake holders and stores said information in a data storage means is included (Figure 19 which it illustrates a data storage means and Figure 15A which it illustrates “Does the Parent Accept or Reject Blowout?” where a user “Accept” (e.g., approve) or “Reject);*

**Claim 5:**

Miller as shown discloses the following limitation:

- *project programs to be changed or to have been changed in said project program change cover: organization change (Figure 3, which it illustrates task details modifications (e.g., organization change));*

Miller teaches that “determining involvement in a new task, the number of levels of involvement in the task can be customised to match a given environment” (Column 9, lines 1-3). Miller does not disclose the following limitation, however Barnard in an analogous art of task management for the purpose of project development (page 2, ¶ 0020) as shown, does:

- *process programs, financial budgets, head count budgets of working persons,, material budgets, risk management programs, procurement programs, quality control programs, operation rules and elemental prescription of contracted agreements* (Figure 2, page 2, ¶ 0022: which teaches that Barnard's system is "for preparing a general procurement and account payable application" and page 3, ¶ 0038, which teaches that Figure 2 illustrates that “the various departments and individuals representing team members 64 include business office 120, architecture 122, education and training 124, project manager 126, Req/Cat development 128, business process design 112,” (e.g., process program) “electronic data interchange (EDI) 114, application development 116,” (e.g., procurement programs) “information technology 130, business controls 132,” (e.g., quality control programs) “procurement process 134, transition management 136, SAP development 138, marketing 118, general procurement operations 98, and support management 96.” where “[e]ach of these departments and individuals perform various rolls and functions during the life of the project from assessment through deployment and use” (e.g., project programs to be changed));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include project programs to be changed as taught by Barnard, to improve Miller task management, thereby giving the predictable result of “tracking team activities” (Barnard, page 2, ¶ 0022) and to control and monitor “a project by storing and maintaining the result of the project activities” in order “to ensure consistency and data accuracy” (Barnard, page 14, Table 9, Description).

The combination of Miller/Barnard does not expressly teach the all the specific data as recited in the limitations, however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ' 2106);

**Claim 6:**

Miller as shown discloses the following limitation:

- *on a basis of a predetermined criterion for evaluating influence against said objects is included* (Figures 15 and 15A, column 10, lines 23-26 where Miller discloses a change involving task dates and how those areas that are affected are informed of the change, the predetermined criteria is the parent task dates and the change is the time blowout);

Miller does not disclose the following limitation, however Barnard in an analogous art of task management for the purpose of project development (page 2, ¶ 0020) as shown, does:

- *a process to infer and specify objects which are to be influenced by said project program change* (page 5, ¶ 0053, page 7 and 9, Table 4, which teaches that "[a] user with appropriate authority may then view, correct, update, approve or otherwise modify the displayed task" where in Table 4 illustrates that when Task ID P83 is modified, the system "[a]ssess customer impact" (e.g., influence) "on internal Enterprise workload" (e.g., object). Barnard teaches that the invention as disclosed infers and specifies objects/task in response to a modification in Task ID P83. In addition, Task ID PD42, the system "[a]ssess supplier impacts related to transition management" (e.g., changes/modifications in transition management) and

Task ID PD43, the system then “[a]ssess Enterprise support impacts related to transition management”);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to determine what objects (e.g., tasks, activities, deliverables) are influenced by a change as taught by Barnard, to improve Miller task management, thereby giving the predictable result of “tracking team activities” (Barnard, page 2, ¶ 0022) and to control and monitor “a project by storing and maintaining the result of the project activities” in order “to ensure consistency and data accuracy” (Barnard, page 14, Table 9, Description).

**Claim 7:**

Miller as shown discloses the following limitation:

- *an initial data regarding project programs is updated only when all relevant stake holders accept an arbitral project program change or said stake holders approve updating of said initial data regarding project program on a basis of a predetermined criterion for evaluating said updating* (column 10 lines 8-10: which teaches that “only the person responsible can accept or reject the recommendation and update task details.”);

**Claim 8:**

Miller as shown discloses the following limitation:

- *said information, being stored in a data storage means therein, of the restrictive condition regarding said project includes at least sequential order of tasks or milestones, due date of contracted matters, available financial budget and operators, an upper limit of quantity of materials, equipments and machineries and restrictive condition based on operation rules and elemental prescription of contracted agreements* ((Figure 19 which it illustrates a data storage means, Figure 1A which it illustrates a sequential order of tasks and their milestones and Figure 2 which it illustrates input for a plan cost (e.g., available financial budget));

Art Unit: 3623

**Claim 10:**

The limitations of claim 10 encompass substantially the same scope as claim 2. Accordingly, those similar limitations are rejected in substantially the same manner as claim 2, as described above.



- 36.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **570.270.3939**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH BOSWEL** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents*

*P.O. Box 1450*

*Alexandria, VA 22313-1450*

or faxed to **571-273-8300**.

Art Unit: 3623

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nadja Chong/

Examiner, Art Unit 3623

/Beth V. Boswell/

Supervisory Patent Examiner, Art Unit 3623